

Jonathan A. Bard, et al.
Serial No.: 10/007,132
Filed: December 3, 2001
Page 2

REMARKS

Election/Restriction

On page 2 of the October 6, 2004 Office Action, the Examiner to whom the subject application is assigned required restriction under 35 U.S.C. §121 to one of the following inventions:

- I. Claims 242, 244-246, and 251-257, drawn to a process for preparing a composition which comprises identifying a chemical compound which is a GALR3 receptor agonist, classification dependent upon compound structure.
- II. Claims 243, 244-246, and 251-257, drawn to a process for preparing a composition which comprises identifying a chemical compound which is a GALR3 receptor antagonist, classification dependent upon compound structure.
- III. Claims 247-248 and 251-257, drawn to a process for preparing a composition which comprises identifying a chemical compound which activates a human or rat GALR3 receptor, classification dependent upon compound structure.
- IV. Claims 249-250 and 251-257, drawn to a process for preparing a composition which comprises identifying a chemical compound which inhibits activation of a human or rat GALR3 receptor, classification dependent upon compound structure.

The Examiner alleged that claims 240 and 241 link inventions I-IV and that the restriction requirement among the linked inventions is subject to the nonallowance of

Jonathan A. Bard, et al.
Serial No.: 10/007,132
Filed: December 3, 2001
Page 3

the linking claims(s), claims 242-257. The Examiner acknowledged that upon allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all of the limitations of the allowable linking claim(s) will be entitled to examination in the instant application.

The Examiner alleged that the search and consideration of a GALR3 agonist that is required for Invention I, is not required by any of the other inventions. The Examiner alleged that the search and consideration of a GALR3 antagonist that is required for Invention II, is not required by any of the other inventions. The Examiner then alleged that the search and consideration of "activating a GALR3 receptor" that is required for Invention III, is not required by any of the other inventions. Finally, the Examiner alleged that the search and consideration of "inhibiting a GALR3 receptor" that is required for Invention IV, is not required by any of the other inventions.

The Examiner advised Applicants that the reply to this requirement must include an election of the invention to be examined even though the requirement be traversed, in order for the reply to be complete (37 CFR 1.143).

The Examiner then concluded that because these inventions are distinct for those reasons stated above, and have acquired a separate status in the art because of their alleged divergent subject matter and separate search requirements, restriction for examination purposes as indicated is proper.

In response to this restriction requirement, Applicants' undersigned attorney, on behalf of Applicants, hereby elects, with traverse, to prosecute the claims of Examiner's Invention IV, i.e. claims 249-250 and 251-257, drawn to a process for preparing a composition which comprises identifying a chemical compound which inhibits activation of a human or rat GALR3 receptor.

Jonathan A. Bard, et al.
Serial No.: 10/007,132
Filed: December 3, 2001
Page 4

Applicants note that a chemical compound which inhibits activation of a human or rat GALR3 receptor (as described in Invention IV) is also a GALR3 receptor *antagonist*. Examiner's Invention II is drawn to a process for preparing a composition which comprises identifying a chemical compound which is a GALR3 receptor *antagonist* (claims 243, 244-246, and 251-257). Contrary to the Examiner's allegation that "Invention IV requires search and consideration of *inhibiting a GALR3 receptor*, which is not required by any of the other inventions", Applicants maintain that the same prior art search for Invention IV would be required for Invention II.

Additionally, Applicants point out that M.P.E.P. §803 states that the Examiner must examine the application on the merits, even though it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden.

Applicants maintain that there would not be a serious burden on the Examiner to examine Inventions II and IV in the subject application.


Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine Inventions II and IV together on the merits.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, Applicants' undersigned attorney invites the Examiner to telephone the number provided below.

Jonathan A. Bard, et al.
Serial No.: 10/007,132
Filed: December 3, 2001
Page 5

No fee, except the fee for a two month extension of time, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 50-3201.

Respectfully submitted,


Mary Catherine DiNunzio, Esq.
Registration No. 37,306
Synaptic Pharmaceutical Corporation
215 College Road
Paramus, New Jersey 07652
(201) 261-1331